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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/911,143 | 07/23/2001 | Hidenori Wada | 10873.772US01 | 4482 |

7590 12/28/2006
Hamre, Schumann, Mueller & Larson
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Minneapolis, MN 55402

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| EXAMINER |
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ORTIZ CRIADO, JORGE L

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| ART UNIT | PAPER NUMBER |
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2627

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 12/28/2006 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/911,143

Applicant(s)

WADA ET AL.

Examiner

Jorge L. Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/12/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/2006 has been entered.

Response to Amendment/Arguments

The affidavit/declaration under 37 CFR 1.132 filed 10/26/2006 is insufficient to overcome the rejection of claim 34 based upon insufficiency of disclosure under 35 U.S.C. 112, first paragraph as set forth in the last Office action because:

The affidavits present insufficient facts to overcome the rejection. The affidavit/declaration provides only speculations that invention could work as claimed and concludes that by the overall description of the specification it would be understood to one skill in the art to find support for the subject matter. But none of the explanations made provides any factual statement that supports the subject matter that is in fact not disclosed. The affidavit's expert described how he would construct the elements necessary to the claimed invention whose construction was not described in the application, this is not sufficient to demonstrate that such

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construction was well-known to those of ordinary skill in the art. Expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight; In re Lindell, 385 F.2d 453, 155 USPQ 521 (CCPA 1967).

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991).

Applicant also argues that Kashiwagi does not disclose “administrative information of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium.” First, the examiner respectfully disagrees because, as outlined above support for this limitations cannot be found in the specification in that the administrative information that includes recording and reproducing condition of the optical recording medium. This limitation is considered new matter. For purposes of examination the examiner has given the broadest reasonable interpretation in view of the supporting disclosure, the administrative information is information recorded in one of the layers of the disk.

Kashiwagi discloses a distance from a cover layer to the first recording layer is 100 mum. The examiner cannot find how the desired information recorded on the disk changes the structure of the recording medium being claimed. The limitation recited must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In this case, the claimed structure of the recording medium

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is met by Kashiwagi, which records information thereon in any of the information recording layers of the recording medium.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 recites the limitation “said administrative information of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium”. The examiner cannot readily ascertain where in the specification as originally filed such a disclosure/support is found and/or cannot find where or how the Applicant defines said administrative information as claimed. The Applicant suggested that the support for this limitation is found in the specification as outlined in the affidavit/declaration filed. However, the examiner cannot concur with the Applicant, because none of the portions cited or any other part of the specification discloses any description that the administrative information includes

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recording and reproducing condition of the optical recording medium and the affidavits present insufficient facts to overcome the rejection. Given the broadest reasonable interpretation in view of the supporting disclosure the administrative information is information recorded in one of the layers of the disk. The limitation is considered new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 34 is rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi U.S. Patent No. 6,175,548.

Kashiwagi discloses an optical recording medium comprising, a base substrate (10), a cover layer (12) through which a laser beams is passed with a wavelength of 390nm to 420 nm, a first recording layer (11B) on which signals are recorded or reproduced with a laser beams having a wavelength of 390nm to 420 nm; and

a second recording layer (11A) on which signals are recorded or reproduced with a laser beams having a wavelength of 390nm to 420 nm,

the first recording layer having recorded thereon "administrative information" of the optical recording medium including at least one of a recording and reproducing condition of the optical recording medium (The first and second layer are "information recording layers", hence having recording thereon information); and

a distance from a surface of the optical recording medium on which the laser beam is incident to the first recording layer is $100\text{ }\mu\text{m} \pm 10\mu\text{m}$ (See col. 1, line 59 to col. 2, line 36; col. 3, line 64 to col. 4, line 41; Figure 2).

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. J.P. Publication No. 03-157816, which discloses an optical recording medium which provides the first recording layer having recorded thereon "administrative information" of the optical recording medium including recording and reproducing condition of the optical recording medium.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(12:30 pm- 9:00 pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

joc


ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER